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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,810	12/11/2000	Scott Leonard Daniels	AUS920000544US1	2972

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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/13/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,810

Applicant(s)

DANIELS ET AL.

Examiner

Longbit Chai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. No claim for priority has been made in this application.
2. The effective filing date for the subject matter defined in the pending claims in this application is 12/11/2000.

Specification

The abstract of the disclosure is objected because the total number of words used in the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5, 13 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention. The claim recites the security code returned by file protocol. However, none of the file protocol is disclosed throughout the entire specification.

4. Claims 6, 7, 8, 14, 15, 16, 21, 22, and 23 are rejected by virtue of dependency on the claim 5, 13 and 20.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 – 8, 13 – 16, and 20 – 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 5, 13 and 20 recites the limitation "said file protocol" in line 4. There is insufficient antecedent basis for this limitation in the claim. The claims 6 – 8, 14 – 16, and 21 – 23 not addressed are rejected by virtue of their dependency.

7. Claims 6 and 21 recites the limitation "said authentication code" in line 3. There is insufficient antecedent basis for this limitation in the claim. The claim limitation "said authentication code" is viewed as "said security code", as best understood, for further examination purpose. The claims 22 and 23 are also rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1 – 7, 9 – 15, 17 – 22, and 24 – 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kern (Patent Number: US 6336187 B1), hereinafter referred to as Kern.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

9. As per claims 1 and 9, Kern discloses a method and computer program product comprising:

- a. providing a hardware-level security code for a storage device on which is stored an electronic file to which restricted access is desired (Kern: inter alia, Column 3 Line 11 – 14); and
- b. allowing access to said storage device only when a user enters a user code that matches said security code (Kern: inter alia, Column 5 Line 35 – 37 and Column 10 Line 50 – 51: Reference access key reads on security code and host/user presented key reads on user code).

10. As per claims 2 and 10, Kern teaches the claimed invention as described above (see claim 1 and 9 respectively). Kern further teaches initializing said security code within a microcode of said storage device, wherein access to said storage device is denied during said initializing step (Kern: inter alia, Column 8 Line 25 – 27 and Figure 4).

11. As per claims 3 and 11, Kern teaches the claimed invention as described above (see claim 2 and 10 respectively). Kern further teaches defining an operating system (OS) extension and corresponding OS extension process by which said allowing step is implemented (Kern: inter alia, Column 9 Line 19 – 25 and Figure 5).

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12. As per claims 4 and 12, Kern teaches the claimed invention as described above (see claim 3 and 11 respectively). Kern further teaches adding a hardware security code checking process to an OS operation for supporting a security code comparison with a user access code when a user requests a read and write on said storage device (Kern: inter alia, Column 4 Line 22).

13. As per claim 17, Kern discloses a data processing system comprising:

- a. a processor, a memory linked to said processor via an interconnect, an input/output (I/O) device (Kern: inter alia, Figure 2);
- b. a drive on which is stored one or more files for which restricted access is desired (Kern: inter alia, Column 7 Line 37 – 38); and
- c. an OS executing on said processor that provides support for assigning a hardware-level security code for said drive and allows access to said file by user only when a user entered access code matches said security code (Kern: inter alia, Column 7 Line 66 – 67, Column 12 Line 53 – 56 and Column 5 Line 35 – 37).

14. As per claim 18, Kern teaches the claimed invention as described above (see claim 17). Kern further teaches said OS includes an OS extension by which an assigning of said security code and access to said drive are implemented (Kern: inter alia, Column 8 Line 11 – 14 and Figure 4 Element 414).

15. As per claim 19, Kern teaches the claimed invention as described above (see claim 18). Kern further teaches:

- a. adding a hardware security code checking code to an OS operation for supporting a security code comparison with a user access code when a user

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requests a read and write on said drive (Kern: inter alia, Column 5 Line 8 – 11);
and

b. identifying specific locations on flash ROM or EEPROM that houses drive microcode on said drive for initializing said security code (Kern: inter alia, Column 6 Line 67 and Column 7 Line 1 – 4).

16. As per claims 5, 13 and 20, Kern teaches the claimed invention as described above (see claim 4, 12 and 18 respectively). Kern further teaches:

a. evaluating via said hardware security code checking process said security code returned by said file protocol (Kern: inter alia, Figure 5 Element 510); and

b. in response to said security code having a predetermined default value, providing said user with unrestricted access to said storage device (Kern: inter alia, Column 7 Line 38 – 39 and Column 7 Line 47 – 48).

17. As per claims 6, 14 and 21, Kern teaches the claimed invention as described above (see claim 5, 13 and 20 respectively). Kern further teaches comparing said security code with said user provided access code when said authentication code is not said pre-determined default value (Kern: inter alia, Column 7 Line 42 and Column 10 Line 1 – 2).

18. As per claims 7, 15 and 22, Kern teaches the claimed invention as described above (see claim 6, 14 and 21 respectively). Kern further teaches outputting an access deny message of said user (Kern: inter alia, Column 10 Line 3 – 4).

19. As per claim 24, Kern discloses a storage system comprising:

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a. recordable medium for recording data (Kern: inter alia, Column 3 Line 10 – 13 and Column 7 Line 5); and

b. a security code that is unique to said storage system and which protects said data recorded on said recordable medium from unauthorized access (Kern: inter alia, Column 3 Line 10 – 13).

20. As per claim 25, Kern teaches the claimed invention as described above (see claim 24). Kern further teaches the storage system of Claim 24, further comprising:

a. an input/output mechanism (Kern: inter alia, Figure 1 Element 106, Figure 2, Column 6 Line 26 – 28 and Column 6 Line 29 – 33); and

b. means for issuing said security code to a requesting operating system extension (Kern: inter alia, Column 5 Line 13 – 15 and Column 5 Line 49 – 53).

21. As per claim 26, Kern teaches the claimed invention as described above (see claim 25). Kern further teaches said input/output mechanisms connects said storage system with a data accessing device (Kern: inter alia, Figure 1 Element 106).

22. As per claim 27, Kern teaches the claimed invention as described above (see claim 26). Kern further teaches said data accessing device is a processor on which said requesting operating system process executes (Kern: inter alia, Column 4 Line 62 – 63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 8, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kern (Patent Number: US 6336187 B1), hereinafter referred to as Kern, in view of Wu (U.S. Patent Number 5,774,551), hereinafter referred to as Wu.

24. As per claims 8, 16 and 23, Kern teaches the claimed invention as described above (see claim 7, 15 and 22 respectively). Kern teaches outputting an access deny message of said user. Kern does not expressly teach restricting a subsequent request for access to said storage device by a user when said security code does not match said user access code during an initial request by said user; and terminating a job submitted by said user.

25. Wu teaches restricting a subsequent request for access to said storage device by a user when said security code does not match said user access code during an initial request by said user (Wu: inter alia, Column 14 Line 4 – 11: Wu teaches the authentication attempts can't exceed a predetermined maximum number).

26. It would have been obvious to the person of ordinary skill in the art at the time the invention was made to combine the teaching of Wu within the system of

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Kern because this improves the system efficiency to eliminate the indefinite login attempt during the authentication process.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 703-305-0710. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
Art Unit 2131

LBC


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